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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,721	03/29/2001	Keiichi Onodera	P107156-00060	4071

7590 12/07/2004

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EXAMINER

DAVIS, DAVID DONALD

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,721

Applicant(s)

ONODERA

Examiner

David D. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8, 9, 11, 13-15, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Taira et al (US 5,809,003). As per claims 8 and 14, Taira et al shows in figure 4 information recording and reproducing medium. Figure 5A shows the medium including a first area 17 in which information can be recorded optically on one side of the medium; and a second area 18 for recording visual information on another side thereof. Figure 5a of Taira et al shows that both sides are visually distinguishable due to difference between the first area 17 and the second area 18.

As per claim 9, figure 4 of Taira et al shows that the first area 17 includes a first recording layer 11A, and the second area 18 includes a second recording layer 11B, both recording layers are made of different material, i.e. two distinct or separate materials. Alternatively, column 5, lines 14-25 of Taira et al states that the two different materials are dissimilar substances.

As per claim 11, Taira et al shows in figures 4 and 5a that a difference in contrast between a written section of the information and a non-written section thereof, after recording the information, is more magnified in the second recording layer 11B than in the first recording

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layer 11A. As per claims 13 and 19, Taira et al shows in figure 5A that the another side of the medium includes visual image pattern including text or a design as a pit art or printing.

As the claims 15 and 17 are directed to information recording and reproducing medium, per se, the method limitations appearing in the claim can only be accorded weight to the extent that they affect the structure of the completed information recording and reproducing medium. Note that “[d]etermination of patentability in ‘product-by-process’ claims is based on product itself, even though such claims are limited and defined by process [i.e., “recorded . . . with a give heat” or “recorded . . . by a light beam”], and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior product was made by a different process”, *In re Thorpe, et al.*, 227 USPQ 964 (CAFC 1985). Furthermore, note that a A[p]roduct-by-process claim, although reciting subject matter of claim in terms of how it is made [i.e., “recorded . . . with a give heat” or “recorded . . . by a light beam”], is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations≡, *In re Hirao and Sato*, 190 USPQ 685 (CCPA 1976).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 10, 12, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira et al (US 5,809,003) in view of Tsutomu (JP 59-215892). Taira et al discloses the claimed invention. See the description, *supra*. However, Taira et al is silent as to the first and second recording layers are made of different organic dye material; both the first and second areas being re-writable and a material in which a chemical change is caused by a given heat, such as a cyanine based organic dye and/or an azo based organic dye.

Tsutomu shows and discloses the recording layer being formed from either one of a cyanine based organic dye and an azo based organic dye.

It would have been obvious to a person having an ordinary skill in the art at the time the invention was made to provide the recording layer of Kozo et al with either one of a cyanine based organic dye and an azo based organic dye as taught by Tsutomu. The rationale is as follows: one of ordinary skill in the art at the time the invention was made would have been motivated to provide a recording layer with either one of a cyanine based organic dye and an azo

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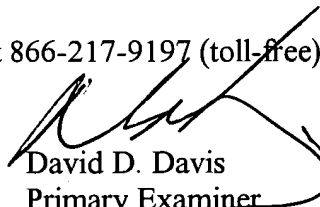
based organic dye to "obtain a recording medium having excellent light resistance and a high reflectance". See the Abstract of Tsutomu.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Davis whose telephone number is (703) 308-1503. The examiner can normally be reached on Monday thru Friday between 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David D. Davis
Primary Examiner
Art Unit 2652

ddd